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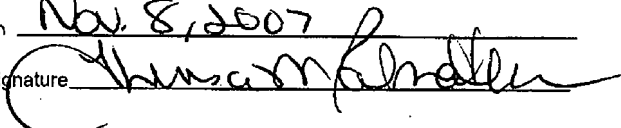
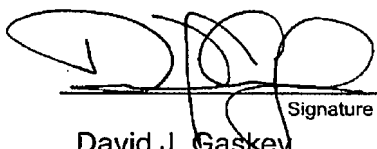
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PTO/SB/33 (07-05)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		60,469-037; OT-4812	
<b>CERTIFICATE OF FACSIMILE</b> I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300. on <u>Nov. 8, 2007</u> Signature <u></u> Typed or printed name <u>Theresa M. Palmateer</u>		Application Number <u>09/921,803</u>	Filed <u>08/03/2001</u>
		First Named Inventor <u>O'Donnell, Hugh James</u>	
		Art Unit <u>3654</u>	Examiner <u>Kruer, Stefan</u>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Typed or printed name <u>David J. Gaskey</u>	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,139</u>		Telephone number <u>(248) 988-8360</u>	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Date <u>8 NOV 2007</u>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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60,469-037  
PA-000.04812-US

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Hugh James O'Donnell  
Serial No.: 09/921,803  
Filed: 08/03/2001  
Group Art Unit: 3654  
Examiner: Krueger, Stefan  
For: ELEVATOR BELT ASSEMBLY WITH WAXLESS COATING

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests Pre-Appeal Brief Review of the rejections in the most recent Final Office Action because there is no *prima facie* case of obviousness.

**The rejection of claims 6-8, 17, 21 and 23-26  
under 35 U.S.C. §103 must be withdrawn.**

The Examiner rejects claims 6-8, 17, 21 and 23, based upon the proposed combination of *Wilcox* and *Harper*. The proposed combination cannot be made because it is contrary to MPEP 2143.01(V) and (VI), it provides no benefit and the *Wilcox* reference teaches away from the proposed combination. Each of those three reasons is independently dispositive and requires a conclusion that there is no *prima facie* case of obviousness. The fact that all three of them exist here is an overwhelming indication that there is no *prima facie* case of obviousness.

The Examiner can only establish a *prima facie* case of obviousness by indicating a reason why the teachings of the cited references would be combined. If a proposed combination would render the prior art unsatisfactory for its intended purpose or change the principle of operation of the reference, then that required reason does not exist (e.g., there is no motivation for making the suggested combination) and there is no *prima facie* case of obviousness. Similarly, where there is no benefit to a proposed combination, the reason for making it does not exist and there is no

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*prima facie* case of obviousness. Lastly, where a cited reference teaches away from a proposed combination, that combination cannot be made and does not establish a *prima facie* case of obviousness.

In this case, the *Wilcox* reference expressly requires utilizing a jacket material that includes wax. The *Wilcox* reference teaches that having a wax (e.g., a fatty acid amide) "present in the finished rope" is "beneficial." (See, e.g., column 3, lines 1-3 and lines 59-column 4, line 4) Therefore, the *Wilcox* reference teaches that to serve its intended purpose and maintain its desired principle of operation, a wax must be included in the finished product of that reference. The Examiner's proposal to remove wax from the jacket of the *Wilcox* reference would render the *Wilcox* reference unsatisfactory for its intended purpose. Therefore, MPEP 2143.01 requires a conclusion that there is no *prima facie* case of obviousness.

There also is no *prima facie* case of obviousness because the proposed combination provides no benefit in the context of the *Wilcox* arrangement. *Harper* wants a wax free outer surface on a foamed, molded article to facilitate painting that article (column 1, line 36 through column 2, line 20). The jacket of *Wilcox* is not painted. Therefore, the proposed addition of *Harper's* technique provides no benefit and there is no *prima facie* case of obviousness.

In fact, the proposed combination would remove a benefit required by the *Wilcox* reference. As already mentioned, the *Wilcox* reference includes a wax in the finished product as a beneficial feature. If one were to remove that wax from the finished product, not only would that not provide any benefit to the *Wilcox* arrangement, but moreover, it would remove a stated benefit that *Wilcox* desires. Such a modification to a reference cannot be made when attempting to establish a *prima facie* case of obviousness.

Further, there is no *prima facie* case of obviousness here because the *Wilcox* reference teaches away from the Examiner's proposed combination. The *Wilcox* reference teaches, for example, "It is an object of the present invention to provide a synthetic plastic rope which can be made using conventional rope making techniques and equipment." (Column 1, lines 44-46)

The Examiner's proposed combination requires taking *Harper's* technique that is different than "conventional rope making techniques" as desired by *Wilcox*. Therefore, the Examiner's proposed combination does not find any suggestion in the references. Instead, the *Wilcox* reference teaches away from the Examiner's proposed combination, which would require using some technique that is not conventional to the rope making art. The technique of the

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*Harper* reference has usefulness in the context of making molds that will be painted, which is not part of conventional rope making as mentioned by *Wilcox*.

The *Wilcox* reference expressly teaches that including a wax (e.g., fatty acid amide) in the finished product of *Wilcox* provides a benefit. (Column 3, lines 59-61) It, therefore, teaches away from an arrangement that would remove that beneficial wax. The *Wilcox* reference teaches away from the Examiner's proposed combination, which would remove *Wilcox*'s beneficial wax.

For any one of the three reasons mentioned above (e.g., the proposed combination renders *Wilcox* unsatisfactory for its intended purpose, the proposed combination provides no benefit and the *Wilcox* reference teaches away from the proposed combination), the rejection has to be withdrawn because there is no *prima facie* case of obviousness. Since all three of them are true, there is no *prima facie* case of obviousness and the rejection based upon the proposed combination of *Wilcox* and *Harper* must be withdrawn.

**The rejection of Claims 16, 18-19, 20 and 22  
under 35 U.S.C. §103 must be withdrawn**

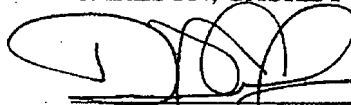
Applicant respectfully traverses the rejection of claims 16, 18-19, 20 and 22 based upon the proposed combination of *Wilcox*, *Harper* and *Aulanko, et al.* For the reasons already mentioned, *Wilcox* and *Harper* cannot be combined. The proposed addition of *Aulanko, et al.* does not remedy the defect in the improper base combination. There is no *prima facie* case of obviousness.

**Conclusion**

Applicant believes that this case is in condition for allowance and respectfully requests a Notice of Allowance as soon as possible. This case has now been pending for more than six years.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.



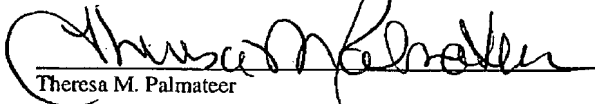
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Dated: 8 Nov 2007

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CERTIFICATE OF FACSIMILE

I hereby certify that this Pre-Appeal Brief Request for Review, relative to Application Serial No. 09/921,803, is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on Nov. 8, 2007

  
Theresa M. Palmateer

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